



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,072	07/02/2001	Stephen W. Scherer	086671/0113	2291

7590

09/26/2002

Bernhard D Saxe
Foley & Lardner
Suite 500
3000 K Street NW
Washington, DC 20007-5109

EXAMINER

EINSMANN, JULIET CAROLINE

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 09/26/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/744,072

Applicant(s)

SCHERER ET AL.

Examiner

Juliet C Einsmann

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1634

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1, 2, 3, 4, 5, 6, and 20-22, drawn to nucleic acids encoding a protein tyrosine phosphatase which is associated with Lafora's disease.

Group II, claim(s) 7, 8, and 16, in part, and claims 9 and 10, drawn to a method of detecting Lafora's disease via the detection of a C→T mutation at position 721 of SEQ ID NO: 1.

Group III, claim(s) 7, 8 and 16, in part, and claims 11 and 12, drawn to a method of detecting Lafora's disease via the detection of a G→A mutation at position 836 of SEQ ID NO: 1.

Group IV, claim(s) 7, 8, 15 and 16, in part, and claim 13, drawn to a method of detecting Lafora's disease via the detection exons 1 and 2 of the Lafora disease gene.

Group V, claim(s) 7, 8, 15 and 16, in part, and claim 14, drawn to a method of detecting Lafora's disease via the detection exon 2 of the Lafora disease gene.

Groups VI-XV, claims(s) 7, 8, and 16, in part, drawn to a method of detecting Lafora's disease via the detection any one of the particular mutations listed in Table 3. (These groups include each of the mutations ten mutations recited in Table 3 that are not recited in one of groups II-V). Each group corresponds to a method which utilizes the detection of a particular mutation. Upon election, please specifically designate the elected method via identification of the mutation.

Group XVI, claim(s) 17 and 18, drawn to isolated proteins.

Group XVII, claim(s) 19, drawn to methods for detection of Lafora's disease via the detection of a deletion or mutation in a protein. Claim 19 does not particularly recite a mutation to be detected. However, the specification recites thirteen different mutated forms of the polypeptide. Upon election of group XVII, Applicant should further identify a particular mutation for examination.

Art Unit: 1634

2. The inventions listed as Groups I-XVII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:
3. The nucleic acids of group I do not provide a special technical feature over the prior art because the subject matter of claim 3 is not a contribution over the prior art. Claim 3 is not entitled to the priority claim because the priority documents do not disclose SEQ ID NO: 1 in its entirety. Serratos et al. (Human Molecular Genetics, Vol. 8, No. 2, pages 3450352) disclose an isolated nucleic acid that comprises a fragment of SEQ ID NO: 1 that is at least 15 bases long and that would hybridize to SEQ ID NO: 1 (see Figure 4A). Thus, the invention as claimed does not provide a special technical feature over the prior art.
4. The groups comprising polypeptides and polynucleotides encoding them lack a shared special technical feature because these groups contain distinct products lacking the same or corresponding special technical features. The polypeptides are composed of amino acids and can be used to raise antibodies, for example. The nucleic acids are composed of nucleotides and function in, e.g., methods of nucleic acid hybridization or amplification. As the products of different sets of groups differ from each other in structure, function, and effect, they do not belong to a recognized class of chemical compound, or have both a "common property or activity" and a common structure as would be required to show that the inventions are "of a similar nature."
5. The special technical feature of each of groups II-XV is considered the particular mutation that is being detected in the target gene. None of these particular mutations share a special technical feature with the other because they are distinct features of nucleic acids having separate structure and effect on the encoded polypeptide. The chemical structure of each mutation and of each molecule containing the same differ from each other. Thus, the separate methods are not joined by a common feature, but instead each have their own special technical feature.
6. Further, the different methods of groups II-XV and group XVII do not share a common special technical feature because they require different process steps since one requires the analysis of nucleic acids and one requires the analysis of polypeptides.
7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

Art Unit: 1634


currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Juliet C. Einsmann whose telephone number is (703) 306-5824. The examiner can normally be reached on Monday through Friday, from 9:00 AM until 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones can be reached on (703) 308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 and (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

September 20, 2002


W. Gary Jones
Supervisory Patent Examiner
Technology Center 1600


Juliet C. Einsmann
Examiner
Art Unit 1634